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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/213,856	12/17/1998	SCOTT ANTHONY MORGAN	N0484.70331US00	6318

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WOLF GREENFIELD & SACKS, P.C.
600 ATLANTIC AVENUE
BOSTON, MA 02210-2206

EXAMINER

ARMSTRONG, ANGELA A

ART UNIT	PAPER NUMBER
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2626

MAIL DATE	DELIVERY MODE
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03/28/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/213,856

Applicant(s)

MORGAN ET AL.

Examiner

ANGELA A. ARMSTRONG

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/ are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

**This Office Action is in response to the Board of Patent Appeals and Interferences
Decision of 9/22/04 and the Terminal Disclaimer filed 10/06/04.**

Terminal Disclaimer

The terminal disclaimer filed 10/6/04 is not accepted. The language used in the disclaimer "35 U.S.C. Sections 154 to 156 and 173" is not proper since the 155 and 156 statutes do not cover the same rights. The disclaimer should refer to "35 USC sections 154 and 173." Accordingly, the double patenting rejection is maintained as indicated below.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re*

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Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 7,206,747 in view of Morin (US Patent No. 5,748,841).

3. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims includes the limitations of predetermining a plurality of speech commands associated with a corresponding plurality of system actions, detecting speech commands and words associated with speech commands, displaying speech commands, performing the corresponding system action if a particular command is selected. Application No. 09/213,858 does not teach determining relevant commands or displaying relevant commands based on the detection of non-command speech terms. Refer to Morin et al who teach a computer speech recognition system which receives a speech input from the user, processed the speech input and determines if the speech input is related or representative of valid commands, and

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identifies to the user said valid system commands applicable to a computer application or program (col. 19, line 20 – col. 20, line 64), for the purpose of allowing users unfamiliar with available commands of an application to progressively build sentences which will have meaning to the application (col. 1, lines 15-20).

4. Therefore, it would have been obvious to one of ordinary skill at the time of invention to modify the speech recognition system of Application No. 09/213,858 to process speech input to determine if the speech input is related or representative of valid commands, and identify to the user the valid system commands, as taught by Morin et al, for the purpose of allowing users unfamiliar with available commands of an application to progressively build sentences which will have meaning to the application, as also taught by Morin et al.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 11-15 are rejected under 35 U.S.C. 101 because the claimed invention fails to be directed to only statutory subject matter. Claims 11-15 are directed to a computer readable medium. In analyzing claims under 35 USC 101, the specification is reviewed for applicant's description of the medium. Per the specification (page 15, lines 8-24), the description of the medium is open-ended ("e.g." at line 13) and given its reasonable broadest interpretation the medium can include both statutory and non-statutory (signals, carrier waves) forms of media. Further, lines 16-19 disclose transmitting the program instructions via the Internet, thereby

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directing the medium to a signal. As a signal does not fall within one of the four eligible categories of invention under 35 USC 101, the claimed invention is directed to non-statutory subject matter not eligible for patent protection and is rejected under 35 USC 101.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANGELA A. ARMSTRONG whose telephone number is (571)272-7598. The examiner can normally be reached on Monday-Thursday 11:30-8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Wozniak can be reached on 571-272-7632. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular communications and (571) 273-8300 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-7241.

Angela A Armstrong
Primary Examiner
Art Unit 2626

/Angela A Armstrong/
Primary Examiner, Art Unit 2626

AAA
March 24, 2011